



Serial No.: 10/647829
Confirmation No.: 2942
Applicant: PATEL, Arvind D.
Atty. Ref.: PA-00409US

REMARKS:

REMARKS REGARDING SPECIFICATION AMENDMENTS:

The specification and abstract have been amended as indicated above. Specifically, Applicant's representative has reviewed those portions of the specification regarding the definition of the various olefin materials that are combined to achieve the results of the present invention and inserted the term "fraction" where appropriate. This addition has been made to make clear that the Applicants have found that a blend of three or more internal olefin fractions have surprisingly been found to be able to achieve a level of environmental compatibility not possible by the three fractions alone. As noted in paragraph 0034 of the published specification, none of the fluids alone have the properties of high biodegradability and low toxicity needed to minimize the environmental impact of such fluids.

Support for the above amendments to the claims can be found in the original specification as filed, and more specifically, support may be found in various sections and paragraphs of the original specification including: paragraph 0023, paragraph 0024 and the associated unnumbered table; paragraph 0025 and associated unnumbered table; paragraph 0027; paragraph 0030 to 0035; Table 1; paragraph 0036; Examples 1 and 2; paragraphs 0105 - 0107, claim 1-18 and the Abstract.

Further it should be noted that one of ordinary skill in the art of chemistry and the formulation of drilling fluids & muds would understand that phrases such as "C₁₆-C₁₈ internal olefin" inherently is referencing an internal olefin fraction having a blend of hydrocarbon molecules having a carbon base chain length in the range of 16 to 18 carbon atoms. As the Courts have noted in the case of *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991), to satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in that context, is whatever is now claimed. Further as indicated in M.P.E.P Section 2163.07 "Mere rephrasing of a passage does not constitute new matter. Accordingly, a rewording of a passage where the same meaning remains intact is permissible. *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973). The



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mere inclusion of dictionary or art recognized definitions known at the time of filing an application would not be considered new matter."

In view of the above, Applicants submit that no new matter has been included within the above amendments and thus request that the Examiner enter the above amendments to the specification.

REMARKS REGARDING CLAIMS AMENDMENTS:

Claims 1, 2 and 13-17 have been amended as indicated above. Specifically the claims have been amended to make clear that the Applicants have found that a blend of three or more internal olefin fractions have surprisingly been found to be able to achieve a level of environmental compatibility not possible by the three individual fractions alone. As noted in paragraph 0034 of the published specification, none of the fluids alone have the properties of high biodegradability and low toxicity needed to minimize the environmental impact of such fluids.

Support for the above amendments to the claims can be found in the original specification as filed, and more specifically, support may be found: paragraph 0023, paragraph 0024 and the associated unnumbered table; paragraph 0025 and associated unnumbered table; paragraph 0027; paragraph 0030 to 0035; Table 1; paragraph 0036; Examples 1 and 2; paragraphs 0105 - 0107, claim 1-18 and the Abstract.

In view of the above, Applicants submit that no new matter has been included within the above amendments and thus request that the Examiner enter the above amendments to the claims.



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IN RESPONSE TO THE OFFICE ACTION:

INFORMATION DISCLOSURE STATEMENT:

Examiner indicated the absence of an Information Disclosure Statement in the case. Applicants representative has consulted the inventors and reviewed the case file. An electronically filed supplemental Information Disclosure Statement has been filed with the Office on the same date as the current paper. A copy of the e-filed documents and confirmation will be provided on request.

OBJECTION TO THE OATH:

Examiner has objected to the Oath as lacking the dated signature of one of the inventors. Submitted with this paper is a supplemental oath containing the dated signature of Stephen Rabhke. Also submitted with this paper is a copy of the original Oath, which in combination with the supplemental oath meets the requirements of 37 CFR 1.66 and 1.68.

OBJECTION TO THE SPECIFICATION UNDER 35 U.S.C. § 112:

Examiner has objected to the specification under 35 U.S.C. § 112 as allegedly lacking the "full, clear, concise and exact terms" required to describe the Applicants' invention.

In response, Applicants' representative has carefully reviewed the specification and presented that above noted amendments intended to address the specific concerns indicated by the Examiner in the Office Action. Applicant submits that the above amendments are nothing more than a rephrasing of terms and language already present in the original specification. As noted above in the Remarks of the Amendment of the Specification, one of ordinary skill in the art of chemistry and the formulation of drilling fluids & muds would understand that phrases such as "C₁₆-C₁₈ internal olefin" inherently is referencing an internal olefin fraction having a blend of hydrocarbon molecules having a carbon base chain length in the range of 16 to 18 carbon atoms. As the Courts have noted in the case of *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991), to satisfy the written description requirement, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention, and that the invention, in



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that context, is whatever is now claimed. Further as indicated in M.P.E.P Section 2163.07 "Mere rephrasing of a passage does not constitute new matter. Accordingly, a rewording of a passage where the same meaning remains intact is permissible. *In re Anderson*, 471 F.2d 1237, 176 USPQ 331 (CCPA 1973). The mere inclusion of dictionary or art recognized definitions known at the time of filing an application would not be considered new matter."

Applicant submits that the above amendments obviates the rejection of the claim under 35 U.S.C. § 112, first paragraph, and thus ask that the Examiner reconsider and withdraw the objection to the specification in the next paper from the Office.

REJECTION UNDER 35 U.S.C. § 112:

Examiner has rejected claims 1-8 and 13-18 under 35 U.S.C. § 112, second paragraph as allegedly being indefinite and failing to particularly point out the Applicants' invention.

In response, Applicant has amended the claims to address the issues raised by the Examiner. Specifically, the claims have been amended to make clear that the Applicants have found that a blend of three or more internal olefin fractions and a rheology control agent have surprisingly been found to be able to achieve a level of environmental compatibility not possible by the three individual fractions alone. As noted in paragraph 0034 of the published specification, none of the fluids alone have the properties of high biodegradability and low toxicity needed to minimize the environmental impact of such fluids.

Applicant submits that the above amendment obviates the rejection of the claim under 35 U.S.C. § 112, second paragraph, and thus ask that the Examiner reconsider and withdraw the rejection of the claim and indicate allowance in the next paper from the Office.

REJECTION UNDER 35 U.S.C. § 102:

Claims 1-8 and 13-18 have been rejected under 35 U.S.C. §102 as being anticipated by US Patent No. 5589442 of Jeffrey C. Gee et al. (the Gee reference). In response, Applicants request that the Examiner reconsider and withdraw the rejection in view of the following.

For there to be anticipation under 35 U.S.C. § 102, "each and every element" of the claimed invention must be found either expressly or inherently described in a single prior art



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reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) and references cited therein. See also *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 1571, 230 U.S.P.Q. 81, 84 (Fed. Cir. 1986) ("absence from the reference of any claimed element negates anticipation."); *In re Schreiber*, 128 F.3d 1473, 1477, 44 U.S.P.Q.2d 1429, 1431 (Fed. Cir. 1997). As pointed out by the court, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the field of the invention. *ATD Corp. V. Lydall, Inc.*, 159 F.3d 534, 545, 48 U.S.P.Q. 2d 1321, 1328 (Fed. Cir. 1998). See also *In re Spada*, 911 F.2d 705, 708, 15 U.S.P.Q. 2d 1655, 1657 (Fed. Cir. 1990).

The Gee reference is directed to a drilling fluid containing linear olefins with 12 or more carbon atoms. However, nothing the Gee reference teaches that a specific combination of internal olefin fractions can be used to obtain the present invention. Applicants have found that a blend of three or more internal olefin fractions and a rheology control agent have surprisingly been found to be able to achieve a level of environmental compatibility not possible by the three individual fractions alone. As noted in paragraph 0034 of the published specification, none of the fluids alone have the properties of high biodegradability and low toxicity needed to minimize the environmental impact of such fluids. Further, nothing in the Gee reference teaches or suggest the need or use of rheology modifier as is positively recited in the claims.

In view of the above, Applicants request the reconsideration and withdrawal of the rejection of claims under 35 U.S.C. §102 and ask that the Examiner indicate the allowance of the claims in the next paper from the Office.

REJECTION UNDER 35 U.S.C. § 102:

Claims 1, 5-8 and 13, 15 and 17 have been rejected under 35 U.S.C. §102 as being anticipated by US Patent No. 6323157 of Joel F. Carpenter et al. (the Carpenter reference). In



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response, Applicants request that the Examiner reconsider and withdraw the rejection in view of the following.

For there to be anticipation under 35 U.S.C. § 102, "each and every element" of the claimed invention must be found either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) and references cited therein. See also *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 1571, 230 U.S.P.Q. 81, 84 (Fed. Cir. 1986) ("absence from the reference of any claimed element negates anticipation."); *In re Schreiber*, 128 F.3d 1473, 1477, 44 U.S.P.Q.2d 1429, 1431 (Fed. Cir. 1997). As pointed out by the court, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the field of the invention. *ATD Corp. V. Lydall, Inc.*, 159 F.3d 534, 545, 48 U.S.P.Q. 2d 1321, 1328 (Fed. Cir. 1998). See also *In re Spada*, 911 F.2d 705, 708, 15 U.S.P.Q. 2d 1655, 1657 (Fed. Cir. 1990).

The Carpenter reference is directed to a drilling fluid containing base oils that are comprised of a mixture of internal predominantly linear tetradecene (C14) isomers and internal predominantly linear hexadecene (C16) isomers.. However, nothing the Carpenter reference teaches that a specific combination of internal olefin fractions can be used to obtain the present invention. Applicants have found that a blend of three or more internal olefin fractions and a rheology control agent have surprisingly been found to be able to achieve a level of environmental compatibility not possible by the three individual fractions alone. As noted in paragraph 0034 of the published specification, none of the fluids alone have the properties of high biodegradability and low toxicity needed to minimize the environmental impact of such fluids. Further, nothing in the Carpenter reference teaches or suggest the need or use of rheology modifier as is positively recited in the claims.



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In view of the above, Applicants request the reconsideration and withdrawal of the rejection of claims under 35 U.S.C. §102 and ask that the Examiner indicate the allowance of the claims in the next paper from the Office.

The undersigned representative authorizes the Commissioner to charge any additional fees under 37 C.F.R. 1.16 or 1.17 that may be required, or credit any overpayment, to Deposit Account No. 13-3082, Order No. PA-00409US.

In order to facilitate the resolution of any issues or questions presented by this paper, the Examiner should directly contact the undersigned by phone to further the discussion.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Carter J. White".

Carter J. White

Patent Counsel

Reg. No. 41374

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Date: 1/9/06